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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,846	12/22/2003	David W. Park	25088	9192

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WEYERHAEUSER COMPANY
INTELLECTUAL PROPERTY DEPT., CH 1J27
P.O. BOX 9777
FEDERAL WAY, WA 98063

EXAMINER

CORDRAY, DENNIS R

ART UNIT	PAPER NUMBER
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1731

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/05/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/05/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@weyerhaeuser.com

Office Action Summary	Application No. 10/743,846	Applicant(s) PARK ET AL.
	Examiner Dennis Cordray	Art Unit 1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,11,15,16 and 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,11,15,16 and 21-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments and amendments, filed 9/21/2006, have overcome the previous rejections. Therefore, the rejections have been withdrawn. However, upon further consideration, new grounds of rejection are made as detailed below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 11, 15-16 and 25-35 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The method of making an **uncoated** paper having the claimed properties and composition is critical or essential to the practice of the invention, but not included in the claims and not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

The claims describe an uncoated printing paper, properties of the paper and the composition of the paper. The instant Specification describes an uncoated paper that is subsequently treated with a composition applied to reduce curl, cockle or other deformation after printing with high levels of ink jet ink **as compared to uncoated paper** [emphasis added] (p 5, lines 19-22). The material is applied by a size press, blade coater or other coating apparatus, thus forming a coating on the paper (p 6, lines

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1-3 and line 21, Example 1; p 7, lines 1-4; p 8, lines 12-16; p 9, lines 1-4; p 10, lines 3-6; p 11, lines 9-11, Figure 13).

The Specification distinguishes the treated paper from uncoated paper, only disclosing how to make a coated paper by applying a coating to an uncoated paper, thus does not enable one of ordinary skill in the art to practice the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Recht et al (EP 1149949 A2).

Recht et al discloses a printing paper having a visual cockle value of 2 or 3 (p 4, Table s 1 and 2; p 5, Table 3). From the test results given in Table 5 of the instant Specification, a visual rank of 2 or 3 corresponds to the claimed cockle level.

Recht et al discloses examples wherein the basis weight of the paper is 75 g/m² (51 lb/3300 ft²) (p 3, line 52).

The product of Recht et al appears to be the same as or similar to the claimed product, a paper having a maximum cockle value of 0.25. The burden therefore shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product.

Claims 1-2, 11, 15-16 and 21-24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bokelman et al (5152304).

Bokelman et al discloses a paper for wrapping a smoking article that comprises a burn modifier (Abs). The burn modifier is monosodium salt of citric acid (col 2, lines 62-68) and is applied in an amount from about 1.2 to about 2.5% by weight of sodium (from 11.2 to 23.3% monosodium citrate, or from about 220 to about 460 lb/ton of paper) (col 3, line 64 to col 4, line 2). The paper basis weight is from 40 to 75 g/m² (or from about 27 to about 51 lb/3300 ft²) (col 4, lines 31-33). The papers comprise cellulose fibers (col 2, lines 47-48).

The paper of Bokelman et al has the same structure as the claimed paper, thus is water fast and has the claimed Cockle Value because, where the claimed and prior art apparatus or product are identical or substantially identical in structure or composition, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). In other words, when the structure recited in the reference is substantially identical to that of the claims, the claimed properties or functions are presumed to be inherent. The recitation of an uncoated printing paper in the preamble is an intended use that does not affect the composition recited in the claims. In any case, cigarette wrappers are typically printed with lines, company logos and/or other product indicia (if evidence is needed, see Seymour et al, US 2004/0118416, p 5, par 44), thus the paper of Bokelman et al can be printed on.

Claims 25-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bokelman et al in view of Ashcraft et al (US 2003/0131860).

Bokelman et al does not disclose other additives in the cigarette wrapper.

Ashcraft et al discloses cigarette wrappers coated with compositions comprising cellulose fibers, burn additives, starch or polyvinyl alcohol binders and optical brighteners. The coating can be done via blade coating, knife coating and by spraying, which are methods recited in the instant Specification for applying the composition to paper (Abs; p 2, par 19; p 7, par 53; p 9, par 67; p 11, par 76). Optical brighteners allow automated equipment to properly align the coatings (p 4, par 31).

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The art of Bokelman et al. Ashcraft et al and the instant invention is analogous as pertaining to papers comprising cellulose fibers and monosodium citrate. It would have been obvious to one of ordinary skill in the art to incorporate starch or polyvinylalcohol binders and optical brighteners in the cigarette paper of Bokelman et al in view of Ashcraft et al as well known additives and to aid automated equipment in processing.

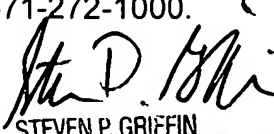
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Cordray whose telephone number is 571-272-8244. The examiner can normally be reached on M - F, 7:30 -4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


DRC


STEVEN P. GRIFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700